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| 09/890,025      | 01/29/2002  | Paul Steabben Hepworth | 20010326.ORI        | 5916             |

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EXAMINER

CHOI, STEPHEN

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,025

Applicant(s)

HEPWORTH, PAUL STEABEN

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“said slidable member” lacks positive antecedent basis.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiotani et al. (US 5,293,802).

Regarding claim 1, Shiotani discloses all the recited elements of the invention including a base (2), cutting means (S), guide means having respective portions wherein one of the portions comprising relatively movable two components (407, 409, 30) and one side of an apparatus being linked to the other of the portions by means of a mechanical connection (see Figure 35, via 411). Regarding claim 2, a locking lever (404). Regarding claim 3, a grip bar (30), a slidable member having a surface (407),

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and at least one wing having a surface (300). Regarding claim 6, a pivot pin (405).

Regarding claim 7, cam means (406). Regarding claim 8, a clamp (414) and a lip (31g).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al. (US 5,293,802) in view of Schnitzer (US 2,342,700).

Shiotani discloses the invention substantially as claimed except for a plurality of ribs and at least one complementary engagement rib. Schnitzer discloses a plurality of ribs (8) and at least one complementary engagement rib (14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of ribs and at least one complementary engagement rib as taught by Schnitzer on the device of Shiotani in order to improve locking of guide means in a desired position.

7. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al. (US 5,293,802) in view of Metzger, Jr. et al. (US 4,846,036).

Shiotani discloses the invention substantially as claimed including a slidable bar (411) and a guide fence (499). Shiotani fails to teach interengaging projection and slot means. Metzger discloses interengaging projection and slot means (see Figure 3, at 81). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to provide interengaging projection and slot means as taught by Metzger on the device of Shiotani in order to provide means for movably connecting the clamping assembly. Applicant should note that the limitation "slot means" is not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35 USC 112, 6th paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence. The "means for" must be modified by functional language. Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use plastic mouldings, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

8. Claims 10-13, 16-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al. (US 5,293,802) in view of Denmead (US 1,826,056).

Shiotani discloses the invention substantially as claimed except for article location means. Denmead discloses article location means (31) including a right-angled recess (32), lips (see Figures 1-2), an arcuate slot (see Figure 2), and a clamping element (33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the article location means as taught by Denmead on the device of Shiotani in order to provide means for positioning the workpiece in a desired angle relative to a cutter. Regarding claim 17, the modified device of Shiotani discloses an indicator (protractor). However, the modified device of Shiotani fails to disclose the indicator provided at the guide means. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to provide the indicator on the guide means, since it has been held that rearranging parts of an invention involves only routine skill in the art.

9. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al. (US 5,293,802) in view of Denmead (US 1,826,056) as applied to claim 10 above, and further in view of Ruben (US 2,990,862).

The modified device of Shiotani discloses the invention substantially as claimed except for a slidable member. Ruben discloses a slidable member (8) to slidable move article location means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the slidable member as taught by Ruben on the modified device of Shiotani in order to provide means for slidably positioning the article locations means along the guide means to facilitate positioning of the workpiece.

### ***Response to Arguments***

10. Applicant's arguments filed 26 September 2003 have been fully considered but they are not persuasive.

Applicant contends that Shiotani lacks "a mechanical connection that pulls and pushes the other of said portions into and out of engagement respectively with the other side of the apparatus" since a connection rod 411 of Shiotani does not connect to the other portions on the other side of the apparatus and the connecting rod 411 cannot pull the portions on the other side of the apparatus.

The examiner respectfully disagrees. Element 414 is mechanically associated with element 411 such that the movement of the element 411 pushes and pulls the

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element 414 into and out of engagement respectively with the other side of the apparatus. Thus, Shiotani meets the above-mentioned limitation since "a mechanical connection" does not require elements to be directly attached to each other. It merely requires elements to be associated mechanically to pull or to push. Webster's New Riverside University Dictionary (definition v. 2.) connect: to associate or relate.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-

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9306. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

SC  
December 4, 2003

  
**STEPHEN CHOI**  
**PRIMARY EXAMINER**